

REMARKS

Claims 1-99 were presented for examination.

Claims 1-99 were rejected.

Applicant is hereby amending claims 1, 39, 60, and 81-99; all of the foregoing merely to distinctly claim his invention.

Applicant thanks the Examiner for his time in conducting a telephone interview on June 15, 2005. Applicant believes that the time was spent effectively and significant progress was made. During the telephone interview, Applicant, Applicant's attorney and the Examiner discussed claims 1 and 60 with respect to the cited Lemelson reference. Applicant compared the co-propagating beams shown in Figs. 5, 6 and 8 in Applicant's pending application to the intersecting beams shown in Figs. 3 and 4 of Lemelson. For the reasons given in more detail below, Applicant and the Examiner agreed that the co-propagating beams were patentably distinctive over Lemelson's intersecting beams and clarification of the claim language to more distinctly claim this aspect would overcome the rejections based on Lemelson.

Reconsideration of this application as amended and allowance of all pending claims, claims 1-99 as amended, are hereby respectfully requested.

Claims 81-99

In the first paragraph of the Office Action, claims 81-99 were rejected under 35 U.S.C. §101 as directed toward non-statutory subject matter because the claimed subject matter did not include tangible computer readable medium. Claims 81-99 have been amended to recite a

“computer-readable medium.” Applicant respectfully submits that claims 81-99 are directed to statutory subject matter and request withdrawal of the rejection under 35 U.S.C. §101.

Claims 1-80

In paragraphs 2-6 of the Office Action, claims 1-80 were rejected variously under 35 U.S.C. §102(b) in light of Lemelson (US 5,995,866) or under 35 U.S.C. §103(a) in light of Lemelson in combination with various other references. These rejections are respectfully traversed.

Claim 1 concerns an apparatus that delivers multiple laser diagnostic beams in the form of a “combined diagnostic beam.” Applicant respectfully submits that the term “combined diagnostic beam,” as used in the specification, means a beam in which the constituent laser diagnostic beams are co-propagating. Applicant is amending claim 1 to expressly include this limitation but submits that this amendment does not narrow claim 1 since this limitation was inherently contained in the definition of “combined diagnostic beam.” The cited reference Lemelson does not show or suggest co-propagating beams and, in fact, teaches away from the use of co-propagating beams.

In more detail, as pointed out in the interview, Figs. 5 and 6 of the current application show two examples where a combined diagnostic beam (130) includes co-propagating laser diagnostic beams (520A and 520B in Fig. 5, or 630A and 630B in Fig. 6). Fig. 8 shows an example device that can be used to combine laser diagnostic beams (830A and 830B) into such a combined diagnostic beam (130). This feature is beneficial, because it allows multiple diagnostic laser beams to be focused to the same point using a common set of optics and with a low risk of the

multiple beams becoming misaligned. In addition, the combined diagnostic beam is advantageously coupled into an optical fiber for fiber delivery in endoscopic procedures.

Lemelson, on the other hand, teaches away from the use of co-propagating beams. In Figs. 3 and 4 of Lemelson, for example, two laser beams (42 and 47, or 42' and 47') are intentionally positioned such that the three dimensional position of the target (WA) can be determined by the point of intersection of the two beams. By definition, Lemelson's two beams cannot be co-propagating because, if they were, Lemelson would not be able to determine the target position WA. None of the other cited references can cure this defect in Lemelson.

Hence, Applicant respectfully submits that independent claim 1 and its dependent claims are patentable over Lemelson and the other cited references. Furthermore, since all of the other claims contain similar limitations, Applicant respectfully submits that the remaining claims are also patentable over Lemelson and the other cited references.

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Based on the comments above, it is believed that no further issues remain with this application that would prevent patentability. Applicant believes that the application is in condition for allowance of all claims herein, claims 1-99 as amended, and therefore an early Notice of Allowance is respectfully requested. If the Examiner believes that for any reason direct contact with Applicant's attorney would help advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

MICHAEL BLACK

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By: Michael W. Farn

Michael W. Farn
Attorney for Applicant
Registration No. 41,015

Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 335-7823 (Tel)
(650) 938-5200 (Fax)